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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/666,168	09/19/2003	Phillip Martin Gibbs	5490-000301	7099	
7590	12/12/2005		EXAMINER SNOW, BRUCE EDWARD		
Stephen J. Foss Harness, Dickey & Pierce, P.L.C. P.O. Box 828 Bloomfield Hills, MI 48303			ART UNIT		PAPER NUMBER
			3738		

DATE MAILED: 12/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/666,168

Applicant(s)

GIBBS ET AL.

Examiner

Bruce E. Snow

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 14-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 35-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/19/03; 1/26/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group 1 (claims 1-13 and 35-44) and Species 1 (figure 1) in the reply filed on 11/23/05 is acknowledged. The traversal is on the ground(s) that the subject matter of all groups is similar, thus, the field of search would be similar. This is not found persuasive because these inventions are distinct for the reasons given in the restriction requirement and have acquired a separate status in the art requiring different search techniques and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 35-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 35 "said ball portion" lacks antecedent basis.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The following are examples only, it's applicant's duty to

assure all claim terminology is supported in the specification: first member, second member.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 35-44 are rejected under 35 U.S.C. 102(b) as being **clearly anticipated** by Donner (3,003,339).

Claims 1, 10-13, 35-44 are rejected under 35 U.S.C. 102(b) as being **clearly anticipated** by Graf (WO 02/0014, applicant submitted).

Regarding claim 1, the “constraining ring” is interpreted as element 12.

Claims 1-2 and 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Gray, III (5,800,555, applicant submitted).

Gray teaches a prosthetic joint for replacement of a natural joint to resist dislocation, the prosthetic joint comprising:

a liner 14 including an internal concave portion defining an internal concave diameter, and defining an opening having a passage width smaller than said internal concave diameter;

a ball portion 78 having a ball diameter substantially equal to said internal concave diameter', and a constraining ring 68 cooperating with said opening,

wherein said ball portion includes an equator having a diameter similar to said passage width;

wherein said ball portion is adapted to be implanted into said internal concave portion during an operative procedure.

All other claim limitations are self-evident.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 and 35-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noiles (4,978,356) in view of Graf (WO 02/00141).

Referring to at least figures 26-30, Noiles teaches a prosthetic joint for replacement of a natural joint to resist dislocation comprising:

a liner 12 including an internal concave portion defining an internal concave diameter, and defining an opening having a passage width smaller than said internal concave diameter;

a ball portion having a ball diameter substantially equal to said internal concave diameter, and a constraining ring 120 cooperating with said opening,

However, Noiles is silent regarding said ball portion having a cylindrical equator having a diameter to said passage width.

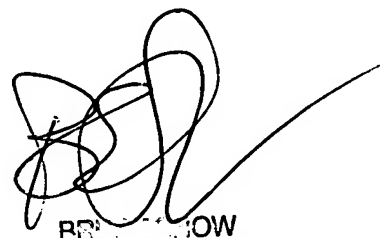
Graf teaches a similar prosthetic joint for replacement of a natural joint to resist dislocation comprising ball 8 having a cylindrical equator 10. It would have been obvious to one having ordinary skill in the art to have utilized the teachings of Graf wherein the ball has a cylindrical equator with the ball of Noiles such that the liner, cup, and retaining ring could be pre-assembled when found desirable by the surgeon and the ball could easily enter the opening passage in an un-anatomical position and lock in an anatomical position within the liner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E. Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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BRIAN J. CHOW
PRIMARY EXAMINER